

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte ANDRE CLAUSSNER,  
FRANCOIS NIQUE,  
JEAN-GEORGES TEUTSCH, and  
PATRICK VAN DE VELDE

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Appeal No. 1997-2792  
Application 08/244,735

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HEARD: December 7, 2000

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Before WINTERS, MILLS, and GRIMES, Administrative Patent Judges.

WINTERS, Administrative Patent Judge.

DECISION ON APPEAL

This appeal was taken from the examiner's decision rejecting claims 1 through 7 and 14 through 16. Claims 8, 9, and 17, which are the only other claims remaining in the application, stand allowed.

A copy of claim 1, which is illustrative of the subject matter on appeal, may be found in the appendix attached to applicants' Appeal Brief.

The references relied on by the examiner are:

Claussner et al. (Claussner)	5,149,696	Sep. 22, 1992
Eur. Pat. App. (Claussner)	384,842	Aug. 29, 1990

The issue presented for review is whether the examiner erred in rejecting claims 1 through 7 and 14 through 16 under 35 U.S.C. § 103 as unpatentable over Claussner (U.S. Patent No. 5,149,696 or European Patent 384,842).

#### Discussion

On consideration of the record, we reverse the rejection under 35 U.S.C. § 103 predicated on each of the above-cited references.

The teaching of each Claussner reference is essentially the same. Each reference discloses 19-nor steroid compounds meeting the terms of independent claim 1 except for applicants' 11-substituted moiety. As best illustrated in U.S. Patent No. 5,149,696, columns 1 and 2, each prior art reference discloses that its 11-substituted moiety terminates at the "left hand" end with a carbamate or amide functional group. The examiner's position to the contrary, notwithstanding, the compounds recited in claim 1 do not include any such carbamate or amide functional group at the 11-position. The examiner does not point to any reason, suggestion, or motivation stemming from the prior art which would have led a

person having ordinary skill from “here to there,” i.e., from the carbamates or amides disclosed in the prior art to the claimed compounds.

The examiner’s decision is reversed.

REVERSED

Sherman D. Winters  
Administrative Patent Judge

Demetra J. Mills  
Administrative Patent Judge

Eric Grimes  
Administrative Patent Judge

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